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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/668,751

09/23/2003

Michael T. Dobbertin

10235

1793

7590

11/01/2004

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EXAMINER

NGUYEN, ANTHONY H

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/668,751

**Applicant(s)**

DOBBERTIN ET AL.

**Examiner**

Anthony H Nguyen

**Art Unit**

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/18/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

*Claim Objections*

Claim 10 is objected to because it is unclear how the stepper motor can adjust the speed of the insert speed adjust unit.

*Claim Rejections - 35 U.S.C. § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gonnella et al. (US 6,608,990) in view of Malachowski et al. (US 5,337,135).

With respect to claims 1, 8, 9 and 16, Gonnella et al. teaches the image-forming production system and method having a marking engine 102 which has an output 140, an inserter 150 ( Gonnella et al., Fig.2) which has insert supplies 152a, 152b and 153c that feed insert sheets with the printed sheets received from the output of the marking engine and a controller (not shown, see Gonnella et al., col.6 lines 62-66) for printing and placing insert sheets with the print sheets. Gonnella et al. does not clearly teach the controller which controls the speeds of the insert sheets from the inserter. Malachowski et al. teaches a printing system having a controller 101 which controls the sheets feeding rate or the speed of the drives feeding the sheets via a variable speed drive and the controller as shown in Figs. 1 and 2 of Malachowski. In

Art Unit: 2854

view of the teaching of Malachowski et al., it would have been obvious to one of ordinary skill in the art to modify the image-forming production system of Gonnella et al. by substituting controller with a variable speed drive unit as taught by Malachowski to improve the efficiency of inserting the insert sheets with the printed sheets at a desired speed in place of the controller of Gonnella et al. With respect to claims 2-7 and 11-20, the selection of desired speed for feeding the sheet at a selected position in the feeding path would have been obvious through routine experimentation in order to get best possible feeding rate in the image-forming production system. With respect to claim 10, the use of a stepper motor for adjusting the speed of the rollers is well known in the art as exemplified by Malachowski et al. (col.6, line 35).

### *Conclusion*

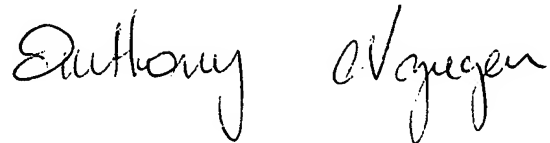
The patents to Seki, Wierszewski, Keller et al., Corad et al. and Rasmussen et al. are cited to show other structures and methods having obvious similarities to the claimed structure and method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169. The examiner can normally be reached daily from 9 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168. The fax phone number for this Group is (703) 872-9306.

Art Unit: 2854

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, reading "Anthony Nguyen". The signature is written in a cursive, flowing style.

Anthony Nguyen  
10/19/04  
Patent Examiner  
Technology Center 2800